<u>REMARKS</u>

Claims 1-19 are pending in the application.

Claims 1-19 stand rejected under 35 U.S.C. 102(e) over Ficco et al. (USP 6,868,292, hereinafter Ficco). The applicant respectfully traverses this rejection.

MPEP 2131 states:

"A claim is anticipated only if *each and every element* as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The *identical invention* must be shown in as *complete detail* as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

The Board of Patent Appeals and Interferences has consistently upheld the principle that the burden of establishing a prima facie case resides with the Office, and to meet this burden, the Examiner must specifically identify where each of the claimed elements are found in the prior art:

"there must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention. Scripps Clinic & Research Found. v. Genentech, Inc., 927 F.2d 1565, 1576, 18 USPQ2d 1001, 1010 (Fed. Cir. 1991). To meet [the] burden of establishing a prima facie case of anticipation, the examiner must explain how the rejected claims are anticipated by pointing out where *all* of the specific limitations recited in the rejected claims are found in the prior art relied upon in the rejection." *Ex Parte Naoya Isoda*, Appeal No. 2005-2289, Application 10/064,508 (BPAI Opinion October 2005).

Claim 1, upon which claims 2-4 and 7-8 depend, claims a method that includes retrieving first documents from a first set of application devices by a server; retrieving an identification of a user by the server; autonomously generating second documents by the server, each comprising at least one instruction, on the basis of at least a part of the retrieved identification of the user and at least a part of the first documents; sending at least one of the second documents to each device of a second set of the application devices by the server; and performing, for a given device of the second set, one instruction from at least one of the second documents received in the given device. Claim 5, upon which claim 6 depends, and claim 12, upon which claims 13-19 depend include similar limitations.

Ficco fails to teach retrieving identification of a user by the server, and fails to teach generating second documents on the basis of at least a part of the retrieved identification of the user and at least a part of first documents.

The Final Office action asserts that Ficco teaches retrieving an identification of a user by the server at column 16, lines 4-6 and Fig 11 & 12 and column 18 35-39. The applicant respectfully disagrees with this assertion. At the first cited text (column 16, lines 4-6), Ficco teaches:

"A spreading-code generator in the transmitter 910 generates a spreading code that identifies the designated device 915." (Ficco, column 16, lines 4-6.)

As previously noted, the cited text fails to address identification of a user, and specifically fails to teach retrieving an identification of a user by a server. Ficco's Figure 10 illustrates a lamp as the example designated device 915; obviously, a spreading code that identifies a lamp cannot reasonably be said to correspond to an identification of a user. Further, the transmitter 910 generates the spreading code that identifies the designated device 915, and does not 'retrieve' an identification, as specifically claimed in claims 1, 5 and 12.

At the second cited text (column 18, lines 35-39), Ficco teaches:

"This may be effected by the well-known shopping cart model, where the user selects scripts to be temporarily buffered until ready to "check-out" at the website. Once completed, the NSP asks the user to confirm selection (Step S4) and prompts the user for downloading to HDD 320 (Step S5). "

The cited text again fails to address identification of a user, and specifically fails to teach retrieving an identification of a user by a server. Although the user selects scripts until "check-out" the user's identification is not addressed. Further, down loading a user's shopping selections/list cannot reasonably be said to correspond to an identification of a user and thus does not 'retrieve' an identification, as specifically claimed in claims 1, 5 and 12.

The Office action also asserts that Ficco teaches generating second documents on the basis of at least a part of the retrieved identification of the user and at least a part of first documents. The Office action asserts that Ficco provides this teaching at column 16, lines 1-4 and 62-67. The applicant respectfully disagrees with this assertion. At the first cited text (column 16, lines 1-4), Ficco teaches:

"Transmitter 910 may also include a high-frequency oscillator that generates a carrier wave, and a high-frequency mixer that modulates the carrier with the baseband signal to generate a narrowband transmit signal." (Ficco, column 16, lines 1-4)

As is evident, the cited text fails to address identification of a user, and specifically fails to teach generating second documents on the basis of at least a part of a retrieved identification of the user, as specifically claimed in claims 1, 5 and 12.

At the second cited text (column 16, lines 62-67), Ficco teaches:

"This present invention is not limited to these methods of script selection. Alternatively, and instead of selecting scripts to be downloaded from the internet, STB 300 may be configured to receive scripts that are downloaded from a satellite system, and/or to receive ...from a satellite TV or cable provider..."
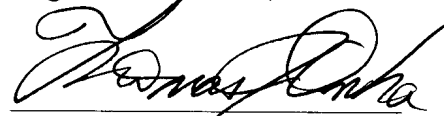
Again the cited text fails to address identification of a user. Further, although Ficco's script selection may be from second sources, it specifically fails to teach generating second documents on the basis of at least a part of a retrieved identification of the user, as specifically claimed in claims 1, 5 and 12.

Because Ficco fails to teach each of the elements of each of the applicant's independent claims 1, 5 and 12, and because the Office action fails to identify where Ficco provides the teachings of each of the elements of claims 1, 5 and 12, the applicant respectfully maintains that the rejection of claims 1-19 under 35 U.S.C. 102(e) over Ficco is unfounded, per MPEP 2131, and should be withdrawn.

For all the foregoing reasons, it is respectfully submitted that all the present claims are patentable in view of the cited references. Entry of this Response and a Notice of Allowance is respectfully requested.

Respectfully submitted,

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